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DEC 03 2007

OFFICE OF PETITIONS

In re Application of :
Kent Johnson :
Application No. 09/893,009 :
Filed: June 28, 2001 :
Attorney Docket No. 650001-162 :

ON PETITION

This is a decision on the petition under 37 CFR 1.78(a)(6) to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of priority of the prior-filed provisional application set forth in the amendment filed concurrently with the instant petition.

The petition under 37 CFR 1.78(a)(6) is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(6) is only applicable to those applications filed on, or after, November 29, 2000. Further, the petition is appropriate only after the expiration of the periods specified in 37 CFR 1.78(a)(5)(ii).

The petition under 37 CFR 1.78(a)(6) must be accompanied by:

1. the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) of the prior filed application, unless previously submitted.
2. the surcharge set forth in § 1.17(t)
3. a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The petition under 37 CFR 1.78(a)(6) lacks item (1) above.

As to item (1), it is noted that the reference required by 35 U.S.C. § 119 and 37 CFR § 1.78(a)(5)(i) to the prior-filed provisional application includes an incorporation by reference statement incorporating the entire disclosure of prior-filed application. It is further noted that the subject application did not contain an incorporation by reference statement on filing in either the specification or application transmittal sheet that included application 60/221,516. The incorporation by reference statement included in the reference required by 35 U.S.C. § 119 and 37 CFR § 1.78(a)(5)(i) is improper as it seeks to include new matter in the application after filing. See 35 U.S.C. § 132. The reference required by 35 U.S.C. § 119 and 37 CFR § 1.78(a)(5)(i) is, therefore, made improper by the inclusion of the incorporation by reference statement.

Before the petition can be granted, petitioner must submit a substitute amendment in compliance with the aforementioned rules, along with a renewed petition under 37 CFR 1.78(a)(6).¹

The issue fee in this case was paid on April 21, 2006. Therefore, it is conceivable that the application will issue before either the filing or the granting of a renewed petition under 37 C.F.R. §1.78(a)(6). In such case, submission of a certificate of correction (along with the \$100 fee and the \$130 processing fee) will be required as a condition for granting the petition under 37 C.F.R. §1.78(a)(6).

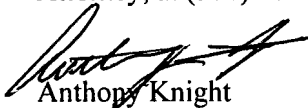
The address cited on the petition differs from the address of record. Although a courtesy copy of this decision is being mailed to the address cited on the petition, all future correspondence will be mailed solely to the address of record until further written instructions to the contrary are received.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

Telephone inquiries concerning this decision may be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.


Anthony Knight
Supervisor
Office of Petitions

cc:
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¹ The claim for priority may also be made in an Application Data Sheet in compliance with 37 CFR 1.121 and 37 CFR 1.76(b)(5).